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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/571,249

03/09/2006

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EXAMINER

NASH, BRIAN D

ART UNIT

PAPER NUMBER

3721

MAIL DATE

DELIVERY MODE

06/03/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/571,249	Applicant(s) SHIMIZU ET AL.	
	Examiner Brian Nash	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner's Comments

1. This action is in response to applicant's amendment received 3/3/2008. The pending claims are now 1-6.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, it is not clear what applicant is claiming or what limitations are encompassed by the claim. Specifically, are the fixed and movable cutter elements connected to, e.g. rigidly affixed thereto, a slide plate element or are the cutter elements merely contained by a slide plate. Appropriate correction is required.

Claim 6, lines 3-7 are indefinite for failing to further limit the structure of the stapler, i.e. limitations of staple legs do not further define the stapler unit. The Examiner notes that claim 6 merely adds the limitation that the movable cutter is pivotal around a shaft.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,844,319 to Kurosawa. Kurosawa discloses a stapler having a striking mechanism portion (14), a movable clincher assembly (25,31,40), a cutter unit having a fixed cutter (36) and a moveable cutter (26) and that is

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arranged slidably between two positions during the operation of the stapler (see col 5, line 25 to col 6, line 15), the fixed and moveable cutters being slideable with the cutter unit assembly. With respect to claim 2, the components of the stapler according to Kurosawa are arranged so that the cutter and clincher mechanisms function while the stapler drives a staple through a stack of sheets and cuts off the excess staple protruding from the opposite side of the stack of sheets.

With respect to claim 3, Kurosawa shows an open area arranged on a lower side of the cutter unit (see Figs. 4a,4b) wherein a staple leg (11a) is cut by the moveable cutting member (26) rubbing on the fixed cutting unit (26) and a cut portion (11b) of the staple leg is discarded.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,844,319 to Kurosawa in view of JP-Y-03-025931 (hereinafter JP '931). As discussed above, Kurosawa discloses the invention substantially as claimed, but does not show a chute for discarding cut pieces of staples that have been cut by the cutter mechanism. JP '931 shows a chute pivotal chute having a first and second end portion arranged at an inclination for the purpose of discarding the cut pieces of the staple legs (see Figs. 1 and 2). It would have been obvious to one skilled in the art to configure/modify the chute mechanism design of Kurosawa with the stapler apparatus of JP '930 for discarding the cut pieces, since such a modification is within the engineering purview of the skilled artisan concerned with removing the cut pieces of the bent staple leg portions so that they do not interfere with the operation of the stapler.

Response to Arguments

8. *In re* claims 1-4 applicants' arguments filed 3/3/2008 have been fully considered but they are not persuasive. Applicant contends, *inter alia*, that Kurosawa has been mistakenly cited by the Examiner as anticipating the claimed invention in lieu of the interview held on 10/18/2007. The Examiner notes that upon initial consideration of the Japanese references and in lieu of only the English abstracts, the claimed invention did not appear to be anticipated; however, upon further consideration of the full English disclosure of Kurosawa the Examiner has cited specific column and lines to further explain how the claimed invention is not novel over Kurosawa. Examiner acknowledges applicant's position; however, a reference is deemed to properly anticipate a claim when all the recited limitations are disclosed therein. In this instance, Kurosawa shows all the recited structural limitations including a stapler having a striking mechanism, a movable clincher mechanism capable of bending staples while moving between two positions and a cutter unit having a fixed and movable element. While it is noted that the device of Kurosawa may not perform the same function or in the same manner as applicant's invention, it is deemed that the claims are not restrictive to such device.

For the reasons above, the grounds for rejection are deemed proper.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Nash whose telephone number is 571-272-4465. The examiner can normally be reached on Monday – Thursday from 8 a.m. to 6 p.m.

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11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached at 571-272-4467. The official fax number for this Group is: 571-273-8300

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Brian D. Nash/
Primary Examiner, Art Unit 3721

5-31-2008